

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sammy M. Chau et al.

Application No.: 10/825,089

Confirmation No.: 7160

Filed: April 15, 2004

Art Unit: 2617

For: INTELLIGENT WIRELESS SWITCH (IWS)
AND INTELLIGENT RADIO COVERAGE
(IRC) FOR MOBILE APPLICATIONS

Examiner: M. G. Manoharan

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

The Appellant hereby requests that a panel of Examiners formally review the legal and factual basis of the rejections of record prior to the filing of an Appeal Brief. This Request is filed with a Notice of Appeal. The review is requested for the reasons stated below.

REASONS FOR REQUESTED PRE-APPEAL REVIEW

I. The 35 U.S.C. § 102 Rejection of Independent Claim 1

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Averbuch et al., United States patent number 5,867,785 (hereinafter *Averbuch*). However, to anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9

U.S.P.Q.2d 1913 (Fed. Cir. 1989). The disclosure of *Averbuch* does not meet the foregoing requirements for a proper rejection under 35 U.S.C. § 102.

Claim 1 recites “associating a station of a wireless switch with a first access point” and “associating a second station of said wireless switch with [a] second access point” To aid the panel in understanding the claimed invention, attention is directed to the specification at paragraph 0024, wherein an embodiment is described with reference to stations 201-1 and 201-2 of intelligent wireless switch 200. As described therein, a first, active mobile radio station (e.g., station 201-1) is associated with a first stationary access point for providing communications, while a second, standby mobile radio station (e.g., station 201-2) is associated with a second stationary access point for providing rapid communication switch-over. In contrast to the express limitations of the claim, *Averbuch* teaches only a single station (mobile base station 206) that communicates with access points (stationary base sites 102-112).

In rejecting the claim, the Appellee relies upon a combination of mobile base sites (202-204), a mobile base station (206), and a mobile system controller (200), final Office Action at page 5. The Appellee asserts that these components of *Averbuch* “perform the functions of Applicant’s intelligent switch 200,” final Office Action at page 2. However, nowhere has Appellee shown a station of *Averbuch* associated with a first access point and a second station of *Averbuch* associated with a second access point. Moreover, Appellant cannot identify any interpretation of the operation of mobile base sites 202-204, mobile base station 206, and mobile system controller 200 which can be read to teach, whether expressly or inherently, associating a first station of a wireless switch with a first access point and associating a second station of the wireless switch with a second access point. Accordingly, *Averbuch* does not anticipate the claim under 35 U.S.C. § 102.

Further emphasizing the above differences between the claimed invention and the system of *Averbuch*, claim 1 recites “monitoring signal strengths of said first and second access points as received by said first and second stations; and switching to routing data between said plurality of wireless devices and said second access point using said second station in response to said monitoring.” Accordingly, signal strength of the first access point as received by the first station is monitored and signal strength of the second access point as

received by the second station is monitored, whereby data routing is switched to the second access point using the second station in response to such monitoring. The single mobile base station (206) of *Averbuch* is not taught to provide the foregoing first and second access point signal strength monitoring for switching data routing between first and second stations. Indeed, Appellee relies upon disclosure of *Averbuch* which teaches mobile system controller 200 comparing carrier to interference to a threshold for selecting channels for use by the mobile base site that will not interfere with channels assigned to the stationary base sites, final Office Action at page 5. The portion of *Averbuch* relied upon in rejecting the claims is simply not relevant to the claim limitations which require monitoring signal strengths of first and second access points as received by the recited first and second stations and switching data routing to use the second station and second access point in response to the monitoring.

Accordingly, a *prima facie* showing of anticipation under 35 U.S.C. § 102 has not been made with respect to claim 1. As such, Appellee asserts that claim 1 and the claims dependent therefrom are improperly rejected.

II. The 35 U.S.C. § 103 Rejections of Independent Claims 9 and 13

Claims 9 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Averbuch* in view of Park et al., United States patent number 6,609,003 (hereinafter *Park*). However, to establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The Appellee has not established that *Averbuch* in view of *Park* meet the foregoing criteria.

Claim 9 recites “a plurality of stations for communicating with external access points; and a packet switch controller for routing data between said plurality of wireless devices and external access points using said plurality of stations” Claim 13 recites “a plurality of stations for communicating with said plurality of access points [and] a packet switch controller . . . wherein said packet switch controller switches between said plurality of stations in response to signal strengths received from said plurality of access points”. In

rejecting claim 9, the Appellee asserts that *Averbuch* teaches “a plurality of stations (item 206, integrated into a single station),” final Office Action at page 7 (emphasis deleted). The foregoing assertion by the Appellee requires a rewriting of the express language of the claim in order to delete the word “plurality”. Yet, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art,” see M.P.E.P. § 2143.03. Appellant submits that no claim would be considered patentable if it were proper to arbitrarily delete words of the claim where the applied art does not meet a particular recited aspect.

Apparently recognizing the folly of the foregoing position, Appellee further asserts that *Park* teaches a plurality of stations communicating with external access points, final Office Action at pages 7 and 8. However, the portion of *Park* identified by the Appellee in rejecting the claims does not teach a plurality of stations, as set forth in the claim, communicating with external access points. Instead, *Park* teaches a stationary base station providing diversity using multiple antennas, see column 6, lines 33-36. The mobile station of *Park*, the device which communicates with the access points (base stations), is taught to have a single radio front end, see column 7, lines 48-53, and Figure 4A. Accordingly, the disclosure of *Park* does not meet the recited plurality of stations for communicating with access points set forth in the claims.

Moreover, even if one of ordinary skill in the art were to spontaneously decide to add a plurality of stations for communicating with access points to the system disclosed in *Averbuch*, as proffered by the Appellee, the claimed invention would not result. For example, adding such stations to “provide macro diversity” as proffered by the Appellee would merely result in each such station communicating with a same access point in order to obtain advantages of diversity, see e.g., *Park* at column 6, lines 28-31 (“a base station distributes user data to multiple antennas on a time-division basis to perform a transmission diversity function, and a mobile station demodulates the received diversity data . . .”). In order to utilize a plurality of stations such that a packet switch controller is operable to switch communications between the plurality of stations in response to signal strengths received from the plurality of access points crossing thresholds, substantial unsuggested modification in addition to adding stations for communicating with external access points would be required.

Accordingly, a *prima facie* showing of obviousness under 35 U.S.C. § 103 has not been made with respect to claims 9 and 13. As such, Appellee asserts that claims 9 and 13, and the claims dependent therefrom, are improperly rejected.

III. Summary

In view of the above, Appellant believes the pending application is in condition for allowance. Accordingly, Appellant respectfully requests that the panel withdraw the rejections of record and pass the claims to issue.

Appellant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 64032/P015US/10404210 from which the undersigned is authorized to draw.

Dated: January 12, 2007

Respectfully submitted,

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